

Application No. 10/786,125
Amendment dated January 11, 2006
Reply to Office Action of December 15, 2005

Docket No.: 1215-0506P

AMENDMENTS TO THE DRAWINGS

Attached hereto is (are) two (2) sheet(s) of replacement drawings that comply with the provisions of 37 C.F.R. § 1.84.

It is respectfully requested that the new drawings be approved and made a part of the record of the above-identified application.

REMARKS

Claims 1-4 and 8 are pending. Claim 1 is an independent claim.

Restriction

Claims 5-7 which are drawn to the independent invention have been canceled.

Applicants reserve their right to file a divisional application for the separate invention of Claims 5-7.

Drawings

In Section "2.", of the Office Action, the drawings were objected to. Enclosed are replacement sheets for the original drawings.

The Examiner is requested to reconsider and withdraw the objection to the drawings.

Specification

In Section "3." of the Office Action, the Examiner requested that the specification be reviewed for any errors.

The specification has been amended for editorial purposes.

Reply to Rejection

Claims 1-4 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Glenn et al., U.S. Patent No. 6,528,857 in view of Uchikoba, U.S. Patent No. 6,698,084. This rejection is traversed.

Initially, on page 4 of the Office Action, the Examiner commented on the term "LTCC." The claims have been editorially changed to eliminate the Examiner's concerns regarding the

wording of the claims. Also, other minor editorial changes have been made to the claims. The preamble does not make the claims as “product-by-process claims.” The claims are structure claims and are patentable for the reasons set forth below.

With respect to the rejection under 35 U.S.C. § 103, based on the two references cited above, initially the reference to Uchikoba is not analogous either to the first reference or to the present claims. The Uchikoba reference is not from the same art as the base claim of the present application. Also, one skilled in the art would not consider the Uchikoba reference in solving the problem stated. The Uchikoba reference is only related to bonding a ceramic piece to a circuit. The present claims relate to a plurality of stacked layers of ceramics including metallization in predetermined layers.

The criteria of establishing if the art is analogous or non-analogous is summarized, for example, in the case of *In re Wood*, 5999 F.2d 1032, 202 USPQ 174 (CCPA 1979) wherein the court stated as follows:

The determination that a reference is from a non-analogous art is therefore twofold. First, we decide if the reference is within the field of the inventor's endeavor. If it is not, we proceed to determine whether reference is reasonably pertinent to the particular problem with which the inventor was involved. (Emphasis added.)

As can be seen from the test set forth in the above-noted case, Uchikoba does not meet any of the two tests set forth.

Furthermore, the Examiner has failed to establish a *prima facie* case of obviousness. Initially, there is no motivation to combine these references without benefit of the Applicants disclosure as a template in restructuring the art. See *Hybritech v. Monoclonal Antibodies, Inc.*, 231 USPQ 81, 93 (Fed. Circ. 1986) wherein the court stated as follows:

Focusing on the obviousness of substitutions and differences instead of the invention as a whole, as the District Court did in frequently describing the claimed invention as the mere substitution...was a legally improper way to simplify the difficult determination of obviousness.

Also see *Hartness International Inc. v. Simplimatic Engineering Co.*, 2 USPQ 2d. 1826 (Fed. Cir. 1987) wherein the court stated as follows:

In determining obviousness, the inquiry is not whether each element existed in the prior art, but whether the prior art made obvious the invention as a whole for which patentability is claimed.

In the present rejection the combination of the references does not provide a proper basis for an obvious rejection.

At best, the Examiner's comments regarding obviousness relate to capability of one skilled in the art, which is not a proper basis for rejecting a claim, under 35 U.S.C. § 103. Furthermore, in arriving at a conclusion of obviousness, the Examiner must consider the results achieved by the claimed combination. This has not been done. The results achieved are set forth, for example, in paragraph 0023 of the specification. See *The Gillette Co. v. S.C. Johnson & Son Inc.*, 16 USPQ 2d, 1923, 1928 (Fed. Cir. 1990) which stated as follows:

An analysis of obviousness of a claimed combination must include consideration of the results achieved by that combination. As we explained in *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985): [CITED IN THE MPEP].

Clearly, the Office Action has not considered the results achieved which is a mandate from the court.

The Glenn patent relied on includes electrical conductive layers of a gold-nickel alloy with no suggestion of what the bonding layer consists of. The Uchikoba patent shows a conductive electrode of gold and nickel connected to a gold bump. But what the Examiner has done is merely selected bits and pieces from the references to reject the claims. This is not proper in a rejection under 35 U.S.C. § 103 as set forth in *In re Wesslau* 147 USPQ, 391 (CCPA 1951) wherein the courts stated as follows:

The ever present question in cases within the ambit of 35 U.S.C. § 103 is whether the subject matter as a whole would have been obvious to one of ordinary skill in

the art following the *teachings* of the prior art at the time the invention was made. It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.

The dependent claims, (Claims 2-4) are considered patentable at least for the same reasons as their base claim.

For the reasons set forth above, the Examiner is requested to reconsider and withdraw the rejection of the claims under 35 U.S.C. § 103.

New Claims

New Claim 8

dependent on base Claim 1 has been added. This claim is considered patentable at least for the same reasons as base Claim 1.

CONCLUSION

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Elliot A. Goldberg (Reg. No. 33,347) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

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If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: Jan. 11, 2006

Respectfully submitted,

By William L. Gates

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Attachments – Two (2) sheets of replacement drawings